REMARKS

Claims 1-19 were pending in this application. The Examiner rejected claims 1-3, 8, 9, 11, 13 and 16-17 and objected to claims 4, 10, 12, 14, 15, 18 and 19. The Examiner indicated that claims 4, 10, 12, 14, 15, 18 and 19 would be allowed if recast in independent form. Examiner Lin indicated during a telephone interview on September 29, 2003, that the Office action, at page 4, incorrectly objected to claims 16 and 17 and stated that claims 4, 10, 12, 14, 15, 18 and 19 should have been indicated as allowable, as summarized in form PTO-326 (Office Action Summary).

Claims 1, 9 and 13 have been amended to include the limitations of dependent claim 2 (now canceled). Claims 4, 10, 12, 14, 15, 18 and 19 have been written in independent form to include the limitations of the base claim and any intervening claims. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure and claims. Applicants submit that the present Amendment does not generate any new matter issue.

Initially, Applicants respectfully request the Examiner to expressly consider and make of record, each of the references cited on the form PTO-1449 (submitted on July 11, 2002), by placing her initials next to each of the five references cited. The Examiner is requested to forward a properly initialed copy to Applicants with the next Official action in response to this Amendment.

Claims 1-3, 8, 9, 11, 13 and 16-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Strasser et al. (U.S. Pat. No. 6,427,041, hereinafter "Strasser"). Applicants respectfully traverse the rejection.

Claims 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Strasser et al. (U.S. Pat. No. 6,427,041, hereinafter "Strasser") in view of Singer et al. (U.S. Pat. App. Pub. No. 2002/0172461, hereinafter "Singer"). Applicants respectfully traverse the rejection.

The present invention, as described by claims 1, 9 or 13, is directed to an optical waveguide type filter in which a deflection angle plane is tilted at position of each grating. In contrast, Strasser discloses that the grating periodically perturbation parts are merely tilted with respect to an optical axis. In other words, in Strasser, the deflection angle plane is not rotated. It is well established that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). In the present case, Strasser is silent as to the deflection angle plane being rotated and, therefore, in the absence of any explicit or implicit teaching or suggestion, the rejection is not legally viable and should be withdrawn.

Moreover, the present invention, as described by claims 1 or 9, is directed to a tilted optical fiber grating device in which polarization depending loss (PDL) is improved. However, Strasser does not appear to recognize the advantages achieved with the present

tilted optical fiber grating device. As disclosed in the present specification at page 23, line 23 through page 24, line 13, the following optical fibers were prepared and analyzed. An optical fiber, defined as Comparative Example, was kept as it was, i.e., without twisting, and one in which the optical fiber was provided with one rotation (defined as Example 1) of twisting per 30 mm and then secured to a securing member so as not to be untwisted were prepared. The PDL and cutout amount were measured in each of them. The results are as shown in FIG. 7. While both of them yielded the same cutout amount, the PDL in Comparative Example was the value indicated by broken curve, whereas that in Example 1 was the value indicated by solid curve. It was seen from these results that, while the one in Comparative Example in accordance with the prior art without twisting yielded the maximum PDL value of 0.25 dB, the maximum PDL value of Example 1 in accordance with the present invention provided with twisting was greatly improved to 0.06 dB. Thus, the problems addressed and solved by the claimed invention constitute a potent indicium of nonobviousness which must be given consideration regarding the ultimate legal conclusion of nonobviousness under 35 U.S.C. § 103.

The Examiner relied on the additional teachings of Singer in an attempt to demonstrate that the claimed twisting (claims 5-7) of a part of the fiber and securing the twisted part are known in the art. However, Applicants submit that Singer discloses that the grating periodically perturbation parts are spiral grooves and, therefore, the periodically perturbation parts are vertical perturbation with respect to the optical axis. In other words, the grating device of Singer does not function as a tilted optical grating (loss filter). Thus, contrary to the Examiner's assertion, one of ordinary skill in the art would not have turned to Singer to remedy the deficiencies of Strasser's tilted optical fiber grating device. The

Examiner is merely picking and choosing limitations from the prior art in an improper attempt to back into the present invention, without the requisite motivation. Applicants submit that neither Strasser nor Singer, alone or in combination, suggest the claimed methodology. In fact, the only motivation for such a limitation is Applicants' own disclosure. Applicants' disclosure, however, is forbidden territory for the Examiner to obtain the requisite motivation for combining the applied prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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